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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,756	09/26/2003	Ronald J. Domes	A891338US1	2821

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EXAMINER	
GOLDMAN, MICHAEL H	
ART UNIT	PAPER NUMBER
3688	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/670,756	DOMES, RONALD J.	
	Examiner	Art Unit	
	MICHAEL H. GOLDMAN	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/22/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's response to the restriction election has been received. The following non-final, first action on the merits is in response to applicant's election filing on September 26, 2003. Claims 1-28, as originally filed, are currently pending and have been considered below.

Election/Restrictions

2. Applicant's election with traverse of claims 1-13 and 23-38 in the reply filed on January 22, 2008 is acknowledged.

Examiner considers applicant's traversal arguments persuasive and hereby rejoins claims from Group I and II. Claims 1-28 will be considered, as originally filed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

As per claim 13, line 2 claims "the conversion rate". There is insufficient antecedent basis for this limitation in the claim.

As per claim 13, line 4 claims "the association rules". There is insufficient antecedent basis for this limitation in the claim.

EXAMINER'S NOTE

5. It appears the Applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph in Claims 14-28 by using "means-plus-function" language, such as "means for receiving instructions", "means for matching desired audience", "means for selecting promotional content", etc. in the above claims. In order to successfully invoke the sixth paragraph, a three-prong test must be met. Namely, (1) the claim must use means-plus-function language; (2) the claim itself must not provided structural limitations to the means-plus-function language; and (3) the specification must recite explicit physical structural limitations for the means-plus-function language in the claim. Claims 14, 19-20 and 24-25 for the audio video apparatus as shown in Figures 3 and 4 pass the three prongs test and thus, 35 U.S.C. 112, 6th paragraph has been successfully invoked for these limitations. However, while claims 15-18, 21-23 and 26-28 pass the first two prongs of the test, they do not pass the third prong, since there is no explicit recitation in the specification of any physical structures to perform the functions of the means-plus-function limitations in the claims. The only "structure" for performing the functions in the above claims appears to be system block diagrams/program modules as depicted in Figures 1, 2a and 2b (i.e. virtual structure, not physical structure). Therefore, 35 U.S.C 112, 6th paragraph has not been successfully invoked in Claims 15-18, 21-23, and 26-28. The Examiner will consider the means to perform the claimed functions as any means, physical or virtual, that can perform the function for those claims which do not meet the three prong test.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-7, 14, 15, 16, and 22-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Strietzel (6950804) and in view of Nathan (7293277) and Zanaty (7209766).

As per claim 1, 2, 14, 15, 16, and 22-25 Strietzel discloses a method, system and apparatus comprising:

- targeted promotional content via a centrally controlled audio-visual system (multimedia distribution) (see column 1, lines 8-11);
- determining desired audience for the subject promotion (see column 3, line 8-9 whereby consume has option to receive

advertising (promotion) with content item, examiner construes solving the same problem of determining desired audience);

- selecting promotional content (see column 3, line 14 and lines 19-25);
- matching audience and audience ranking data (see column 3, lines 22-24 whereby content database is configure to track a status of each of the plurality of content items relative to each of a plurality of users, examiner construes as audience ranking data);
- transmitting instructions to at least one audio-visual apparatus with storage means causing promotional content to be presented to at least one audience (see column 3, lines 30-32 whereby upon request of the user, the (system) downloads the content item and any appended advertisement to a PC (audio-visual apparatus with storage means);
- means for handling data representing secure content (see column 13, lines 54-56 whereby encryption and/or license key techniques may be used to secure the content).

However, Strietzel fails to disclose the feature of an audiovisual apparatus comprising a digital video jukebox for use in public places. Nathan discloses the features of digital audiovisual system comprising remote control, storage means, payment means and display means. (see abstract, lines 1-3). Both Strietzel and Nathan disclose systems for distributing multimedia content. Therefore, it would

have been obvious to one skilled in the art at the time of the invention to modify the Strietzel system and method of distributing targeted multimedia content and advertising to include a remote control unit for audiovisual systems as taught by Nathan in order to reach larger audiences and in public places.

However, Strietzel and Nathan fail to disclose at least one self-identifying audio-video apparatus. Zanaty discloses the feature of a self-identifying device (see column 5, lines 2-5). Strietzel, Nathan, and Zanaty disclose a system, method and apparatus for system communication. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the Strietzel system, method and apparatus to include the feature of a self-identifying audio-video apparatus by Zanaty in order to record more accurate data for statistical and demographic analysis resulting in improved matching of promotions to audiences.

As per claim 3, Strietzel, Nathan, and Zanaty disclose the method, system and apparatus as in claim 1 above, but they fail to explicitly disclose the consideration of one or more demographic elements to determine a desired audience for the subject promotions. However, Official Notice is taken that it is old and well known within the marketing industry to use demographic factors to target advertisements, such as detergent companies presenting advertisements for laundry detergents in the late morning and early afternoon serials on television in the 1950's and 1960's - - thus becoming known as "soap operas"

based on their knowledge that the predominant television viewers during these time slots were young housewives. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the invention of Strietzel to use demographic information of the desired audience to select promotions. One would have been motivated to do so in order to provide improved matching of targeted promotions and audiences, thus, increasing the likelihood that the audience will respond favorably to the promotion.

As per claim 4, Strietzel, Nathan, and Zanaty disclose the method, system and apparatus as in claim 3 above, but they fail to explicitly disclose wherein promotional content is presented as one of in addition to and interspersed with secure content. However, it would have been obvious to one skilled in the art at the time of the invention to modify the invention of Strietzel to include wherein promotional content is presented. One would have been motivated to do so in order to improve responses to promotions.

As per claim 5, Strietzel, Nathan and Zanaty disclose the method, system and apparatus as in claim 4 above. However, they fail to explicitly disclose wherein the step of selecting promotional content comprises one or more factors of user preferences. It would have been obvious to one skilled in the art at the time of the invention to modify the invention of Strietzel include one or more user

preferences in the selection of promotional content presented. One would have been motivated to do so in order to improve responses to promotions.

As per claim 6, Strietzel, Nathan and Zanaty disclose the method, system and apparatus as in claim 5 above. However, they fail to explicitly disclose wherein the step of pre-classifying promotional content including reference to an external classification resource. It would have been obvious to one skilled in the art at the time of the invention to modify the invention of Strietzel to include pre-classification and reference to an external source of promotional content. One would have been motivated to do so in order to improve responses to promotions.

As per claim 7, Strietzel, Nathan and Zanaty disclose the method, system and apparatus as in claim 6 above. Strietzel further discloses the step further comprising secure content (see column 13, lines 54-56 whereby encryption and/or license key techniques may be used to secure the content).

8. Claims 8-13, 17-18, 20-21, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strietzel (6950804) in view of Nathan (7293277) and Zanaty (7209766) and further in view of Eldering et al. (7240355).

As per claim 8, Strietzel, Nathan, and Zanaty disclose the method, system and apparatus as in claim 7 above. However, they fail to explicitly disclose the selection of promotional content based upon the presence of specific current patrons or cross-section of patrons in the subject venue.

Eldering et al. discloses the system and method whereby subscriber (user) characterization with filters in which users selections are monitored. The actual user's selection data is used to form program characteristics vectors which via rules indicating the relationships between programming choices and demographics can be applied to generate probabilistic user profiles regarding user programming and product interests. (see abstract, lines 1-17).

Strietzel, Nathan, Zanaty and Eldering et al. disclose systems for distributing multimedia content. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the Strietzel system and method of distributing targeted multimedia content and advertising to include the step of refining the selection of promotional material as taught by Eldering et al. in order to improved matching of promotions and audiences.

As per claim 9, Strietzel, Nathan, Zanaty and Eldering et al. disclose the method, system and apparatus as in claim 8 above. They fail to explicitly disclose the step of providing access to external sources of promotional content for the purposes of uploading and altering said promotional content to audiovisual apparatus. However, it would have been obvious to one skilled in the

art at the time of the invention to modify the invention of Strietzel to include external promotional sources for promotional content. One would have been motivated to do so in order to customize the delivery of the targeted media so as to improve responses to promotions.

As per claim 10 and 20, Strietzel and Nathan, Zanaty and Eldering et al. disclose the method, system and apparatus as in claim 9 above. They fail to explicitly disclose the step of injecting promotional content on short notice. It would have been obvious to one skilled in the art at the time of the invention to modify the invention of Strietzel include injection of promotional content on short notice. One would have been motivated to do so in order to customize the targeted media to changes in the audience so as to improve responses to promotions.

As per claim 11, 21, and 27 Strietzel, Nathan, Zanaty and Eldering et al. disclose the method, system and apparatus as in claim 10 above. Nathan further disclose the features of wireless remote control (wireless handheld), touch screen (see column 2, line 64) and use of coins, notes, tokens, chip cards (smart cards) (see column 3, lines 9-11) as alternative means for the purposes of selection and payment. Strietzel, Nathan, Zanaty and Eldering et al. disclose systems for distributing multimedia content. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the Strietzel

system and method of distributing targeted multimedia content and advertising to include alternative means for selection and payment as taught by Nathan in order to attract a broader spectrum of audiences.

As per claims 12 and 17, Strietzel, Nathan, Zanaty and Eldering et al. disclose the method, system and apparatus as in claim 11 above. Strietzel further discloses the step of tracking consumer purchases and cross-tracking consumption patterns (see column 6, line 47-55 whereby *user's custom indexes may be used to make recommendations for other content items, examiner construes as cross-tracking).*

As per claim 13, 18 and 28 Strietzel and Nathan, Zanaty and Eldering et al. disclose the method, system and apparatus as in claim 11 above. Strietzel further discloses the step of wherein the content server tracks information /statistics for all users by storing information pertinent to content accessed in the tracking base (see column 6, lines 50-55, whereby examiner construes statistics to include tracking the conversion rate).

As per claim 26, Strietzel, Nathan, Zanaty and Eldering et al. disclose the method, system and apparatus as in claim 25 above. They fail to explicitly disclose the means for an initiating promoter to supply or reconfigure promotional content. It would have been obvious to one skilled in the art at the time of the

invention to modify the invention of Strietzel to include the means for the promoter to reconfigure promotional content. One would have been motivated to do so in order to customize the targeted media to changes in the audience so as to improve responses to promotions.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL H. GOLDMAN whose telephone number is (571)270-5101. The examiner can normally be reached on Monday thru Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mhg
March 3, 2008

/James W Myhre/
Primary Examiner, Art Unit 3688